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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,013	11/29/2000	Faisal M. Awada	AUS9-2000-0590-US1	9662
35525	7590	09/22/2004	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,013

Applicant(s)

AWADA ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-9, 11-33 have been examined.

Response to Amendment

2. The Amendment filed on 6/21/04 is sufficient to overcome the Laor, Hidary reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-8, 11-20, 24-25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor (6,041,309) in view of Hidary (5,852,775).

Laor is considered to disclose a method, computer program product, and system comprising:

creating (or instructions for or means for) an electronic database of coupons offered by merchants (please see column 4 lines 38-56 wherein the disclosed book of electronic coupons data structure is considered equivalent to the claimed database);

receiving, sending, submitting, or sending (or instructions for or means for) a request from a user seeking access [to] the database (please see column 6 lines 12-40 wherein the

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disclosed personal computer browser software is considered patentably equivalent to the claimed database access request since coupons are access through the disclosed browser);

determining (or instructions for or means for) a location of the user or (or instructions for or means for) remotely accessing the database (please see column 6 lines 40-60 wherein the disclosed website visits implies that a user is accessing the database at a location determined to be different from the site and implies that a user is remotely accessing a website);

providing (or instructions for or means for) a menu of services, preference selection, or service preferences to the user (please see column 5 lines 1-25 wherein the disclosed listing of available coupons is considered patentably equivalent to the claimed providing menu or preference feature);

receiving (or instructions for or means for) a service preference selection from the user or receiving (or instructions for or means for) coupons based on selected service preferences and present location or transmitting or delivering (or instructions for or means for) the preference selection to the database server (please see column 5 lines 25-47 wherein the disclosed provided coupons from the clearing house is considered patentably equivalent to the claimed preference selection receipt, transmitting, and location features); and

delivering or receiving (or instructions for or means for) coupons to the user based on the selected service preferences and location of the mobile device (please see column 5 lines 48-67 wherein the disclosed distributing and redeeming coupon embodiment is considered patentably equivalent to the claimed delivery or receiving features). Laor is discloses the claimed internet service provider (column 4 lines 15-19) and retail, dining, automobile service, lodging and entertainment service preferences (implicitly disclosed as shopping and spending habits at

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column 3 lines 62-67). Laor is considered to disclose the claimed invention as discussed above except for the claimed mobile communications device and telephone service provider.

Hidary is considered to disclose the claimed mobile communications device including a mobile telephone, at column 3 lines 4-61, wherein the disclosed commercial message or advertisement delivery to a subscriber cellular (wireless or mobile) telephone is considered patentably equivalent to the claimed mobile communication device for receiving and delivery of coupons. In its broadest interpretation in light of the specification, the claimed coupon is an incentive to provide a user motivation to purchase a product or service. Hidary also disclosed that an advertisement acts as an incentive to provide a user motivation to purchase a product or service. Therefore a coupon and advertisement are considered patentably equivalent. Hidary is considered to also disclose the claimed and telephone service provider at column 2 lines 15-67.

It would have been obvious to one skilled in the art to combine the mobile communication teachings of Hidary with the coupon delivery teachings of Laor for the purpose of providing user coupons to various means of communications such as a mobile communication device.

Hidary further discloses that messages or advertisements can be delivered to a user based upon the users' profile, preferences, and users location (col 3, lines 4-50; col 4, lines 25-37) and that messages can be customized to users based on demographics or defined geographic areas (Abstract).

Hidary further discloses that the step of delivering coupons based on selected service preferences and location further comprises selecting advertisements or messages for merchants

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that are within a defined area of the user's location (col 3, lines 4-50; col 4, lines 25-37; Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hidary location based and profile based advertising providing to Laor profile based coupon providing. One would have been motivated to do this in order to provide a further piece of user information that allows better targeting.

4. Claims 6, 9, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor (6,041,309) in view of Hidary (5,852,775) in further view of Green, Jr. (5,926,133).

Laor in view of Hidary is considered to disclose the claimed invention as discussed above except for the triangulation location of the wireless device, wireless server, and merchant selection within a prescribed user location radius. Green is considered to disclose the triangulation location of the wireless device at column 5 lines 9-20, and the wireless server and merchant selection within a prescribed user location radius at column 5 lines 33-48.

It would have been obvious to one skilled in the art to combine the teachings of Laor in view of Hidary with the teachings of Green for the purpose of using wireless location techniques to locate mobile communication device users and wireless server storage and radius determination such that precise marketing and couponing may be affected for both a user and sender.

5. Claims 23, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor (6,041,309) in view of Hidary (5,852,775) in further view of Christensen (6,035,280).

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Laor in view of Hidary is considered to disclose the claimed invention as discussed above except for the feature of consumer profiles based on demographic characteristics with a filtering step. Christensen is considered to disclose the claimed feature of consumer profiles based on demographic characteristics with a filtering step at column 9 lines 4-55.

It would have been obvious to one skilled in the art to combine the teachings of Laor in view of Hidary with the teachings of Christensen for the purpose of accurately target consumers with purchase incentives, such as coupons, based on the demographic characteristics of those consumers.

6. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor (6,041,309) in view of Hidary (5,852,775) in further view of Obradovich (6,148,261).

Laor does not explicitly disclose that the defined area varies based upon the geographic density of merchants proximate to the user's location.

However, Obradovich discloses that the defined area varies based upon the geographic density of merchants proximate to the user's location (col 13, lines 60-col 14, line 15).

Obradovich discloses that selections for merchants can be made based on retail category, maximum number of listings, and distance. Therefore, if a maximum number of listings is 5 for a specific category, then the defined area would be smaller than if the maximum number of listings were set to 10. Hence, the geographic area can vary based upon the density of merchants proximate to the user's location. Furthermore, Obradovich's disclosure enables the user to be informed of the 5 nearest merchants to the user. And, the distance of the furthest of the 5 nearest

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merchants (which defines the geographical area of interest) would vary depending upon the merchant density around a user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Obradovich's varying a defined geographic area based upon number of merchants relative to a user's location. One would have been motivated to do this in order to provide an appropriate or nonoverwhelming number of merchants nearest to a user.

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laor (6,041,309) in view of Hidary (5,852,775) in further view of Sharony (5,742,593).

Laor further discloses a communications channel for transferring coupon information (col 2, lines 5-11).

Laor does not explicitly disclose that the channel is only for coupon information.

However, Sharony further discloses wireless communications (col 1, lines 8-15) and means for delivering advertising comprising a dedicated channel independent of other channels used for normal communications by the mobile communication device (col 5, lines 28-44).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Laor's coupon channel can be a dedicated coupon/advertising channel. One would have been motivated to do this in order to provide fast or reliable communication of advertising or coupon information.

Response to Arguments

8. Applicant's arguments with respect to claims 1-9, 11-29 have been considered but are not found persuasive. Please note the enhanced rejection of the Independent claims above.

New claims 30-33 are rejected above.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Bandera (6,332,127) discloses providing nearest merchant information to user or location based advertising.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

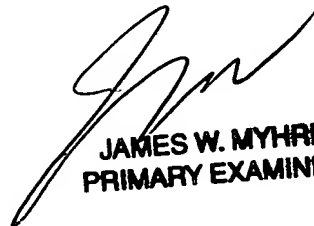
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

9/3/04


JAMES W. MYHRE
PRIMARY EXAMINER